



Paper No. 7

CHIRON CORPORATION INTELLECTUAL PROPERTY -R440
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MAY 14 2002

OFFICE OF PETITIONS

In re Application of
Williams, et al.
Application No. 09/803,719
Filed: March 9, 2001
Attorney Docket No. 2300-1624DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed January 11, 2002.

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on March 9, 2001, without the necessary filing fees or an executed oath or declaration. Accordingly, on April 26, 2001, the Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application. This Notice set a two month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration. To make timely this reply, applicant obtained a five month extension of time and included a Certificate of Mailing dated November 26, 2001. In addition to paying the filing fees, applicant included a declaration signed by inventors Lewis T. Williams, Jaime Escobedo, Pablo Dominguez Garcia, Julie Sudduth-Klinger, Christoph Reinhard, Filippo Randazzo, Giulia C. Kennedy, David Pot, Altaf Kassam, George Lamson, Radoje Drmanac, Mark Dickson, Ivan Labat, Lee William Jones, and Birgit Stache-Crain, but lacking a signature from inventor Michael A. Innis. Accompanying the petition were, *inter alia*: (1) a statement of facts by Nancy L. Swanson, describing how the application papers were transmitted to Innis; (2) a copy of a cover letter transmitting the application papers via Federal Express; and (3) a copy of an e-mail from Innis, in which he stated he would not sign the

declaration until he was paid a consulting fee of \$2,500 per day.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached after diligent effort or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Rule 47 applicant has not met requirement (2) above.

As to requirement (2), the declaration is not acceptable because it does not comply with 37 CFR 1.63(c)(1). The declaration submitted does not identify an acceptable mailing address for non-signing inventor Innis. Regarding the mailing address that must be supplied on the 37 CFR 1.63 oath or declaration, the Manual of Patent Examining Procedure states:

Each applicant's mailing or post office address is required to be supplied on the oath or declaration, if not stated in an application data sheet. Applicant's mailing address means that address at which he or she customarily receives his or her mail. Either applicant's home or business address is acceptable as the mailing address.¹

Here, Rule 47 applicant has supplied a business address for Innis on the declaration. The address provided was: Chiron Corporation, P.O. Box 8097, Emeryville, California 94662-8097. However, as detailed in the papers submitted on petition, Innis is a former employee of Chiron Corporation. In fact, the e-mail refusal from Innis stated that he retired from Chiron two years ago. Therefore, it can not be concluded that Rule 47 applicant has supplied a declaration with an address for Innis at which he "customarily receives mail."

On renewed petition, applicant must submit a declaration in compliance with 37 CFR 1.63.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

¹ MPEP 605.03.

Application No. 09/803,719

Page 3

By hand: Crystal Plaza Four, Suite 3C25
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Telephone inquiries regarding this decision should be directed to
Petitions Attorney Cliff Congo at (703) 305-0272.

Christina Partera Donnell for

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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